

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed December 13, 2004. At the time of the final Office Action, Claims 1-5, 11, 12, 15, 16, 18 and 21-35 were pending in the Application. Claims 1-5, 12, 15, 16, 18 and 21-35 stand rejected. Applicants have cancelled Claims 4, 15, 18, 27-31, 33 and 35. For the reasons provided below, Applicants respectfully request reconsideration and allowance of the pending claims.

Allowable Subject Matter

Applicants again note with appreciation the allowance of Claim 11.

Section 112 Rejections

Claims 4, 18, 27-31, and 35 are rejected under U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claims 18 and 27-29 are rejected under U.S.C. § 112, second paragraph, as being indefinite. Claims 4, 18, 27-31, and 35 are cancelled in this Response and thus these rejections are now moot.

Section 103 Rejections

The Office Action rejects Claims 1, 3-4, 12, 16, 21-23, 25, 32 and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,285,479 to Okazaki et al. ("*Okazaki*") in view of U.S. Patent No. 6,163,527 to Ester et al. ("*Ester*"). Furthermore, the Office Action rejects Claims 1, 3-4, 12, 16, 18, 21-23, 27, 30-32 and 34-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,285,479 to Okazaki et al. ("*Okazaki*") in view of U.S. Patent No. 6,249,510 to Thompson ("*Thompson*"). In addition, the Office Action rejects Claims 2, 5, 24, and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Okazaki* and *Thompson* and further in view of U.S. Patent No. 5,956,319 to Meli. Finally, the Office Action rejects Claims 15, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Okazaki* and *Thompson* in further view of two other references.¹

¹ The Examiner should note that this rejection is now moot in light of the cancellation of Claims 15, 29, and 33.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained at least because the Examiner has failed to provide a suggestion or motivation to combine *Okazaki* with either *Ester* or *Thompson*.

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion,

or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).²

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of the cited references. The Examiner's rationale for combining both *Okazaki* with *Ester* and *Okazaki* with *Thompson* is the same. The Examiner states that these proposed combinations are proper for the following reason:

One of ordinary skill in the art would have been motivated to combine the teaching of Ester et al. [or Thompson] with the ADM of Okazaki et al. because some failure may only affect certain wavelength channels. In such case, an individual channel switching is more effective than a span or ring switching. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use switches between the demultiplexer and multiplexer for individual wavelength protection switching, as taught by Ester et al. [or Thompson], in the ADM of Okazaki et al. because an individual channel switching is more effective for failures that only affect certain wavelength channels.

Furthermore, in the "Response to Arguments" section of the Office Action, the Examiner indicates that the need to protect individual channels in addition to fiber protection "is knowledge generally available to one of ordinary skill in the art and is well documented in the literature." As an example, the Examiner cites to an IEEE Communications Magazine

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

article written by Manchester et al. (“*Manchester*”). However, *Manchester* does not indicate that there is a need to protect individual channels *in addition* to fiber protection, instead it discusses (at a very high level) that channel level switching “may emerge as a more viable alternative” to fiber protection. *Manchester*, p. 49, col. 2, para. 3. Although channel level switching might be an alternative to fiber protection, there is still no motivation or suggestion to modify the teachings of *Okazaki*, which discloses the use of fiber protection, with the teachings of *Ester* or *Thompson*. In fact, the disclosure of the use of fiber protection in *Okazaki* teaches away from modifying the disclosure of that reference to implement a totally different kind of protection switching – channel level switching.

Furthermore, even though *Manchester* teaches that channel level switching may be a “viable alternative” to fiber protection, it provides no details of any device that might implement this functionality. Thus, there is no teaching of combining, for example, components for channel level switching with add or drop couplers for adding or dropping traffic from an optical fiber. Specifically, none of these references suggest the use of add couplers or drop couplers as recited in the rejected claims in combination with channel level switching. Although used by the Examiner as the source of the suggestion to combine, *Manchester* does not provide such a suggestion since it does not provide any details of how a device for channel level switching might be implemented.

Again, as emphasized in both the case law and in the M.P.E.P., simply because references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *See, e.g.*, M.P.E.P. § 2143.01. The desirability that must be suggested is the desirability of the particular combination of components or steps that are recited in the claims, not simply high-level concepts. For at these reasons, Applicants respectfully submit that the suggestion or motivation required by M.P.E.P. § 2143.01 for the proposed combinations does not exist.

Therefore, Applicants respectfully request reconsideration and allowance of pending Claims 1-3, 5, 12, 16, 21-26, 32, and 34, which were all rejected under at least one of the two combination of references discussed above.

CONCLUSION

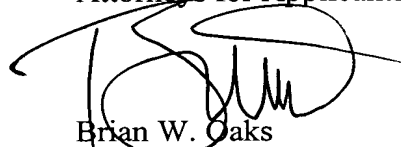
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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